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10/526,338	03/02/2005	Barry Rosenbaum	STYL0162PUSA	8931
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BROOKS KUSHMAN P.C.			BERMAN, SUSAN W	
1000 TOWN CENTER			ART UNIT	
TWENTY-SECOND FLOOR			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,338

Applicant(s)

ROSENBAUM ET AL.

Examiner

/Susan W. Berman/

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9-23, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 24, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/05</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 28 and 29 fail to further limit claim 27. With respect to claim 28, claim 27 limits the solvent system to a system including cyclohexane and isobutyrate, while claim 28 broadly recites generic cycloalkane, cycloalkanone or cycloalkene in combination with an organic ester. With respect to claim 29, which recites selecting cyclohexane or cyclohexanone in combination with isobutyrate, claim 27 requires cyclohexane in combination with isobutyrate.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,890,972. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The claims of US '972 recite a solvent system including cyclohexane and/or cyclohexanone in combination with isobutyrate in an erasable ink composition comprising a rubber and a pigment. The species recited in the claims of US '972 clearly suggest the genus of cycloalkane and/or cycloalkanone set forth in the instant claims, since the same species are recited in the instant claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 7, 9-12, 15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Daugherty et al (4,738,725). Daugherty et al disclose an erasable ink for a ball point pen. Attention is drawn to Example 3 which discloses erasable ink comprising 19% elastomer including blocks obtained from styrene and isoprene, 17.66% pigment, 21.5% cyclohexane, 3.5% ethyl acetate (organic ester), 15-18% mineral oil, and 5% dioctyl phthalate. It

is calculated that the ink comprises 51.41% solvent system which comprises approximately 42% cyclohexane and 6.8% ester. Thus, Daugherty et al clearly anticipate the instant claims.

Claims 1-5, 7, 9-13 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Brenneman et al (4,721,739). Brenneman et al disclose erasable ink for a ball point pen wherein the ink comprises 01.-60% pigment such as carbon black, 8-30% thermoplastic elastomer including that obtained from styrene and isoprene, 10-35% plasticizer or mixtures of plasticizers include dioctyl phthalate and dibutyl phthalate, 10-40% solvent that comprises cyclohexane and esters, and corrosion inhibitor. It is further disclosed that the ink possesses viscosity of 48-500 P or 4800 to 50,000 cP (column 3, lines 49-55, column 4, lines 46-50 and 65, column 5, lines 9-10, column 6, lines 11-16 and 56-60, and column 7, lines 12-13, 17-24, 41 and 46-47). Thus Brenneman et al anticipate the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daugherty et al (4,738,725) in view of Miyajima et al (4,629,748). The disclosure of Daugherty et al is discussed above. Daugherty et al do not teach adding a corrosion inhibitor.

Miyajima et al disclose an erasable ink for a ball point pen discloses using 0.5-6% phosphate ester as corrosion inhibitor in order to prevent rusting at the writing tip (column 2, lines 7-22, 30-37 and 57-58).

It would have been obvious to one skilled in the art at the time of the invention to employ the corrosion inhibitor taught by Miyajima et al in an analogous ink composition in the ink composition taught by Daugherty et al. One skilled in the art at the time of the invention would have been motivated by a reasonable expectation of providing an ink composition that will not rust the writing tip of a ball point pen in which it is utilized.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenneman et al (4,721,739) in view of Miyajima et al (4,629,748). The disclosure of Brenneman et al is discussed above. Brenneman et al teach adding a corrosion inhibitor but do not mention the phosphate ester set forth in the instant claims.

Miyajima et al disclose an erasable ink for a ball point pen discloses using 0.5-6% phosphate ester as corrosion inhibitor in order to prevent rusting at the writing tip (column 2, lines 7-22, 30-37 and 57-58).

It would have been obvious to one skilled in the art at the time of the invention to employ the corrosion inhibitor taught by Miyajima et al in an analogous ink composition in the ink composition taught by Brenneman et al. One skilled in the art at the time of the invention would have been motivated by a reasonable expectation of providing an ink composition that will not rust the writing tip of a ball point pen in which it is utilized.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenneman et al (4,721,739) in view of Williams et al (4,367,966) or Koyama (5,977,211). The disclosure of Brenneman et al is discussed above. Brenneman et al do not teach including a mineral oil as in the instant claims.

Williams et al disclose an erasable ink wherein 0-25% mineral oil is used to improve lubrication and writing quality (column 3, lines 36-42). Koyama discloses an erasable ink wherein 1-5% mineral oil is used as lubricant to improve the writing feel (column 4, lines 5-8, 17 and 35-37).

It would have been obvious to one skilled in the art at the time of the invention to add a mineral oil to the ink compositions disclosed by Brenneman et al in order to improve lubrication and writing quality of the ink, as taught by Williams et al in analogous art. Alternatively, It would have been obvious to one skilled in the art at the time of the invention to add a mineral oil to the ink compositions disclosed by Brenneman et al in order to add a lubricant and improve the writing feel, as taught by Koyama in analogous art.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daugherty et al (4,738,725) or Brenneman et al (4,721,739) each in view of Murakami et al (4,357,431) or Farmer, III (4,391,927). The disclosures of Daugherty et al and Brenneman et al are discussed above. Neither Daugherty et al nor Brenneman et al teaches including a polybutene.

Murakami et al disclose an erasable ink that employs polyisobutylene in order to maintain good erasability (column 2, lines 7-19). Alternatively, Farmer, III, discloses an erasable

ink using polybutene to enhance the cohesive strength of the elastomer and to increase erasability of the ink (column 7, lines 23-49).

It would have been obvious to one skilled in the art at the time of the invention to use polyisobutylene in the ink composition taught by Daugherty et al or by Brenneman et al, as taught by Murakami et al in analogous art, to provide an ink with good erasability. Alternatively, It would have been obvious to one skilled in the art at the time of the invention to use polybutene in the ink composition taught by Daugherty et al or by Brenneman et al, as taught by Farmer, III, in analogous art, to provide an ink with good cohesive strength and good erasability.

Claims 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenneman et al (4,721,739) in view of Murakami et al (4,357,431) or Farmer, III (4,391,927). The disclosure of Brenneman et al is discussed above in the rejection under 35 USC 102(b).

Brenneman et al do not mention employing polybutene, as set forth in the instant claims.

Murakami et al disclose an erasable ink comprising polyisobutylene added to maintain good erasability (column 2, lines 7-19).

Farmer, III, disclose an erasable ink comprising polybutene to enhance the cohesive strength of the elastomer present in the ink (column 7, lines 23-49).

It would have been obvious to one skilled in the art at the time of the invention to add polyisobutylene to the ink compositions taught by Brenneman et al in order to maintain good erasability, as taught by Murakami et al in analogous art.

Alternatively, It would have been obvious to one skilled in the art at the time of the invention to add polybutene to the ink compositions taught by Brenneman et al in order to

enhance the cohesive strength of the elastomer present in the ink, as taught by Farmer, III< in analogous art.

Allowable Subject Matter

Claims 6, 8 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27 and 30 are allowed.

Claims 28 and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Neither Dougherty et al nor Brenneman et al discloses ink compositions wherein the solvent system comprises isobutyl butyrate as required in the claims noted as being allowable. Mathias (5,135,569) discloses ink compositions comprising isobutyl isobutyrate, however, the ink comprises fluorescent dye instead of the pigment set forth in the instant claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Susan W. Berman/ whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB
12/5/2007

/Susan W Berman/
Primary Examiner
Art Unit 1796